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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/391,966	09/08/1999	RICHARD J. DITZIK		9391

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EXAMINER

KINCAID, LESTER G

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 01/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/391,966

Applicant(s)

DITZIK, RICHARD J.

Examiner

Lester G. Kincaid

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 February 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-24 and 26-48 is/are pending in the application.
- 4a) Of the above claim(s) 13, 15-22, 26-30 and 32-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14, 23, 24, 31 and 40-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 12/20/01 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/391,966 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Election/Restrictions***

2. **Claims 13, 15-22, 26-30, and 32-39** are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper Nos. 9,12.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the method(s) including each step must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 14, 23-24, 31, and 40-48** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding **claims 14, 23-24, 31, and 40-43**, the instant specification fails to provide support for a "computer-display handset unit", but instead discloses a computer system, comprising a flat panel display assembly (2) and wireless handset (14). The specification fails to provide for any specific control of the wireless handset, but appears to be somewhat directed to the control of the flat panel assembly (2), however, characterization that the computer-display handset unit is "adapted to wireless communication with a communications base unit" would be contrary to that interpretation, since the assembly (2) appears to most closely resemble the claimed "base". The specification further fails to provide for the "manual or automatic selecting", the "handset" unit being "primarily a personal digital assistant", that the "handset" unit can access the internet, and that the user can look at a display screen while speaking toward a microphone at a distance, in hands-free speaker phone operation. The instant specification also appears to be silent on the "adapting data to wireless communication

protocols and signals step". Finally, the specification fails to provide for the "controlling" methods made up the claimed steps.

Regarding **claims 44-48**, the specification fails to provide for the claimed subject matter as applied above with respect to claims 14-43, in addition, the specification fails to provide for the microprocessor system being in the handset, fails to provide for any data adapting and additionally fails to provide for control of such adapting, transmission, or reception under the microprocessor system. The specification fails to provide for the hands free speaker phone operation with the user looking at a display screen while speaking toward a microphone at a distance.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 14, 23-24, 31, 40-43 and 46-47** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Examples include: in **claim 14**, line 5, the phrase "adapted to wireless communication" is not grammatically correct and should be changed accordingly; and line 8, "includes" is inconsistent with "modes";

**Claim 14** recites the limitations "said hand held computer-display unit" in line 12, "said control program and controlling step" in line 14, and "said plurality of program functions" in line 15. There are insufficient antecedent basisses for these limitations in the claim.

Regarding **claim 14**, the phrase "may include" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding **claim 43**, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

**Claim 46** recites the limitation "said base station unit that is connected to the internet" in line 3. There is insufficient antecedent basis for this limitation in the claim.

**Claim 47** recites the limitation "said base unit that performs the functions of a personal computer or notebook computer" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Please note: that in order that the specification, and all amendments thereto, may be expeditiously handled by the office, it is common practice, and a commendable one, to consecutively number all the lines or every fifth line of each claim.

### ***Claim Objections***

8. **Claim 48** is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper

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dependent form, or rewrite the claim(s) in independent form. Claim 48, being dependent on claim 44, must include every limitation recited in claim 44. Therefore that the "handset unit" is an "earset unit" - instead, is improper since a method/apparatus literally infringing the dependent claim must also literally infringe the independent claim.

9. **Claims 31 and 40-43** are objected to because of the following informalities: the comma after "as" in line 1 should be deleted or moved. Appropriate correction is required.

10. **Claim 14** is objected to because of the following informalities: the "executing" step should be indented and labeled step 'd', to maintain consistency. Appropriate correction is required.

11. **Claim 44** is objected to because of the following informalities: the first occurrence of "RF" should be replaced to read --radio frequency (RF)--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

13. **Claims 14, 23, 40, 41, and 44-48** are rejected under 35 U.S.C. 102(e) as being anticipated by Babitch et al. (U.S. Patent 5,930,719).

As to **claims 14 and 44-48**, Babitch et al. disclose a handset unit (12/10) operated by a user, and method for controlling it, comprising:

executing a micro computer control program (inherent to all cellular telephones, laptop, and desktop computers), the unit (12/14) being adapted for wireless communication with a base unit (18/20) a relatively short distance away, (see col. 1, line 52 through col. 2, line 8 and Figs. 1-4);

selecting a plurality of computing and communication modes, (see col. 4, lines 7-53) wherein the user has the option to run the modes roughly simultaneously (inherent to all computers after 1995);

controlling to appear roughly simultaneous in operation (inherent to all computers after 1995); and

(inherently) executing a plurality of program functions (see col. 4, lines 7-16, etc.).



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As to **claim 23**, Babitch et al. further provide for the handset primarily being a PDA. See col. 4, lines 17-21.

As to **claim 40**, Babitch et al. further provide for the base unit primarily being a portable notebook-like computer system (20) with external communication capability.

As to **claim 41**, Babitch et al. further provide for the unit being adapted to access the internet, (see col. 4, lines 7-16).

14. **Claims 14, 24, 40, 41, and 44-48** are rejected under 35 U.S.C. 102(e) as being anticipated by Lintula et al. (U.S. Patent 5,884,190).

As to **claims 14 and 44-48**, Lintula et al. disclose a handset unit (2) operated by a user, and method for controlling it, comprising:

executing a micro computer control program (inherent to all cellular telephones, laptop, and desktop computers), the unit (2) being adapted for wireless communication with a base unit (1) a relatively short distance away, (see col. 4, lines 1-11);

selecting a plurality of computing and communication modes, (see col. 4, lines 12-19) wherein the user has the option to run the modes roughly simultaneously (inherent to all computers after 1995);

controlling to appear roughly simultaneous in operation (inherent to all computers after 1995); and

(inherently) executing a plurality of program functions. See Fig. 1.

As to **claim 24**, Lintula et al. further provide for the handset primarily being a cellular phone. See col. 3, lines 39-66.

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As to **claim 40**, Lintula et al. further provide for the base unit primarily being a portable notebook-like computer system (1) with external communication capability, see Fig. 1.

As to **claim 41**, Babitch et al. further (inherently) provide for the unit being adapted to access the internet, (see Fig. 1).

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 14, 24, and 44-48** are rejected under 35 U.S.C. 103(a) as being unpatentable over May (U.S. Patent 5,446,783).

As to **claims 14, 24 and 44-48**, May discloses a handset unit (10/40/45) operated by a user, and method for controlling it, comprising:  
executing a micro computer control program (inherent to all cellular telephones),  
the unit being adapted for wireless communication with a base unit (100) a relatively short distance away, (see Figs. 3A-B);  
selecting a plurality of computing and communication modes, (see col. 2, lines 47-66); and

executing a plurality of program functions (see col. 2, lines 47-66). May fails to explicitly recite that the user has an option to run the modes simultaneously and the controlling step of appearing simultaneously.

Applicant has admitted that it was well known in the art at the time the invention was made for computers to run a "windows" operating system that enables a computer to run the modes / programs simultaneously and the controlling step of appearing simultaneously. See page 14 of the instant specification. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system by specifically running a windows operating system on the computer, thus giving the user an option to run the modes simultaneously and thereby performing the controlling step of appearing simultaneously, as claimed, for the purpose of achieving a multitasking operation and thereby increasing user interest and effectiveness.

17. **Claims 14, 23, 24, 31, and 40-48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Siitonen et al. (U.S. Patent 6,049,796) in view of Stein. - as previously applied.

Siitonen et al. disclose everything claimed (Figs. 2A-2B and col. 2, line 15 - col. 3, line 48), however fail to explicitly recite that the modes are run simultaneously. However since Siitonen et al. disclose the computer functions of the PDA are separate from the communication functions of the cellular telephone, it would have been obvious to modify the method to run the functions simultaneously and thereby enable a user to make or receive a wireless call while the computer acts in the PDA functionality. Also

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not disclosed by Siitonen et al. is the communication with a base station only a short distance away, recited in claim 40. However this technique is taught by Stein and would have been obvious to implement for the purpose of enabling the unit to conserve battery power by lowering its transmission power. It would have been obvious to apply the remaining well known features as previously set forth for the purpose of allowing the unit to obtain a more user friendly feature.

### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Harrison et al. (U.S. Patent 5,796,727) further provide for wireless communication and computer units.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lester G. Kincaid whose telephone number is (703) 306-3016. The examiner can normally be reached on Monday through Friday from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703) 305-4385.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 2600 Customer Service Office at (703) 306-0377.

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**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

LGK

January 25, 2002



**LESTER G. KINCAID  
PRIMARY EXAMINER**